

### **REMARKS**

In response to the Office Action dated April 21, 2006, claims 1-8 have been amended and claims 13-51 have been added. Claims 1-51 are now pending in this application. No new matter has been added.

The indication that claims 8-12 are objected to, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims, is acknowledged and appreciated.

### **REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103**

I. Claims 1, 2, 5 and 6 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Kawasaki et al. (US Patent Publication 2002/0142810 A1).

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Thus, a rejection under 35 U.S.C. § 102 requires each element of each claim included in the rejection to be explicitly or inherently disclosed in the single reference.

To expedite prosecution, independent claim 1 has been amended to recite, *inter alia*:

a condition detector for detecting a closed condition and an open condition of the first and second movable parts, wherein

the inner operation section is activated and the outer operation section is deactivated in case the first and second movable parts are in an open condition, and

the inner operation section is deactivated and the outer operation section is activated in case the first and second movable parts are in a closed condition.

In addition, claim 2 has been amended to be in independent form including all the limitations of base claim 1, and additionally recites, *inter alia*:

an externally oriented imaging section provided in the exposed area; and  
a condition detector for detecting a closed condition and an open condition of the first and second movable parts, wherein

the inner operation section is activated and the outer operation section is deactivated in case the first and second movable parts are in an open condition, and

the inner operation section is deactivated and the outer operation section is activated in case the first and second movable parts are in a closed condition.

The features now recited in independent claims 1 and 2, as amended, are not disclosed or suggested by Kawasaki et al. In addition, these features have an advantage of preventing wrong operation. Consequently, independent claims 1 and 2, as amended, as well as amended dependent claims 5 and 6, are patentable over Kawasaki et al.

**II.** Claim 1 has been rejected under 35 U.S.C. § 102(e) as being anticipated by Nagasawa (US Patent Publ. 2004/0077386 A1).

However, Nagasawa also does not disclose or suggest the features now recited in amended independent claim 1. Thus, amended independent claim 1 is patentable over Nagasawa also.

III. Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki et al. The Examiner admits that Kawasaki does not disclose the inner operation section is activated and the outer operation section is deactivated in case the first and second movable parts are in an open condition and the inner operation section is deactivated and the outer operation section is activated in case the first and second movable parts are in a closed condition. Despite such lack of disclosure, the Examiner asserts that he “takes official notice that it would have been obvious to one skilled in the art at the time the invention was made *to activate and deactivate the inner and outer portions when in an open condition and vice versa*.”

However, as amended independent claim 2 is patentable over Kawasaki et al., amended claim 3, depending from amended independent claim 2, is patentable over Kawasaki et al. also.

With regard to taking of official notice by the Examiner that it would have been obvious to one skilled in the art at the time the invention was made *to activate and deactivate the inner and outer portions when in an open condition and vice versa*, the following comments are provided.

The information that the Examiner takes Official Notice of is not capable of instant and unquestionable demonstration as being well-known and therefore, is not the type of which Official Notice can be taken (see MPEP § 2144.03).

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154, USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148

USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by *Graham v. John Deere Co.*, 86 S.Ct. 684, 383 U.S. 117, 148 USPQ 459, 469 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or to combine applied references to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims [at bar] would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

Recognizing, after the fact, that [such] a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, supra.

No specific facts are provided by the Examiner that *to activate and deactivate the inner and outer portions when in an open condition and vice versa* (emphasized portion hereinafter called *feature*) was known in the art to which the invention pertains. Consequently, it is presumed that the Examiner considers the *feature* to be of common knowledge. However, reliance upon “common knowledge” (of what is known) to reject claims is not objective evidence that “*to activate and deactivate the inner and outer portions when in an open condition and vice versa*”, as a whole, is obvious within the meaning of 35 U.S.C. § 103. In this regard,

Applicants stress that what may be known in some general context does not necessarily render the claimed subject matter as a whole obvious within the meaning of 35 U.S.C. § 103.

Specific attention is directed to *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). In this case, the Federal Circuit held that deficiencies of a cited reference cannot be remedied by the Board's general conclusion about what is "basic knowledge" or "common sense" to one of ordinary skill in the art. Further confirmation that the Federal Circuit requires evidence of record, not opinion by the Examiner (or Board), can be found in the case of *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Thus, if the Examiner wishes to establish something is "known", then this needs to be established via objective evidence of record. Factually establishing that the above noted *feature* is "known" in the art to which the invention pertains does **NOT** include an assertion that the Examiner takes official notice that such *feature* is known or obvious to one skilled in the art. Without objective evidence of record, this assertion merely represents the opinion of the Examiner.

Therefore, Applicants specifically request that if the Examiner subsequently contends that "the inner operation section is activated and the outer operation section is deactivated in case the first and second movable parts are in an open condition, and the inner operation section is deactivated and the outer operation section is activated in case the first and second movable parts are in a closed condition" is obvious, then the Examiner cite a reference establishing that this is known in the art and apply this references in the manner specified by *Graham v. John Deere Co.*, supra,

IV. Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki et al. in view of Soini et al. (USPN 6,445,932).

However, Soini et al. also does not disclose or suggest the above noted features that have been added to independent claim 1. Therefore, as amended independent claim 1 is patentable over Kawasaki et al., amended claim 4, depending from amended independent claim 1, is patentable over Kawasaki et al. also, even when considered in view of Soini et al.

V. Claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki et al. in view of Parulski et al. (US Patent Publication 2003/0186708).

However, Parulski et al. also does not disclose or suggest the above noted features that are now recited in independent claim 2, as amended. Therefore, as amended independent claim 2, is patentable over Kawasaki et al., amended claim 7, depending from amended independent claim 2 via amended claim 3, is patentable over Kawasaki et al. also, even when considered in view of Parulski et al.

### **CONCLUSION**

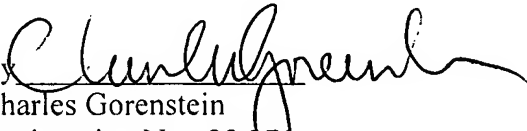
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Edward J. Wise (Reg. No. 34,523) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

CG/EJW/vd

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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